

**PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q87423

Ryuji UENO

Appln. No.: 10/531,874

Group Art Unit: 1614

Confirmation No.: 5640

Examiner: Gregg Polansky

Filed: April 19, 2005

For: PROSTAGLANDIN COMPOUNDS FOR THE TREATMENT OF OBESITY

PETITION TO WITHDRAW FINALITY UNDER 37 CFR 1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request withdrawal of the finality of the Office Action dated October 22, 2010, and issuance of a new Office Action for the reasons discussed below.

On page 5 of the Office Action, claims 1, 5, 7, 11-13, 21, 24, and 25 are rejected under 35 U.S.C. 112, first paragraph, because the Specification, while being enabling for reducing the weight of obese patients by the administration of a 15-keto-16-mono or dihalogen prostaglandin E1 (PGE1) compound, a salt thereof, or an ester or amide of the α chain terminal carboxylic acid, does not reasonably provide enablement for reducing the weight of obese patients by the administration of multitude of prostaglandin compounds as defined by the rejected claims.

However, the Examiner previously indicated that claim 23 was enabled (see page 5 of the May 7, 2010 Office Action), and Applicant notes claim 1 was amended in the August 9, 2010 Amendment to incorporate the compound of claim 23, as well as to make additional narrowing amendments with respect to the scope of that compound. That is, claim 23 was directed to a 15-keto-16-mono or dihalogen-prostaglandin E1 compound within the scope of formula (I) of previous claim 1, upon which claim 23 depended. Present claim 1 is directed to a 15-keto-16-mono or dihalogen-prostaglandin E1 compound represented by formula (II), which is a subgenus of previous formula (I). Since previous claim 23 was enabled, Applicants submit that narrower

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present claim 1, which is within the scope of previous claim 23, should be enabled. However, since the Examiner has rejected it for lack of enablement, the rejection should be made in a non-final Office Action.

Accordingly, Applicant submits that the finality of the present Office Action is improper and should be removed.

In view of the above, Applicant respectfully requests withdrawal of the finality of the Office Action, and issuance of a new, non-final Office Action.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

Date: December 22, 2010